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EXAMINER

COBURN, CORBETT B

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3714

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/783,096
Filing Date: February 15, 2001
Appellant(s): KUSUDA, KAZUHIRO

MAILED
JAN 22 2006
GROUP 3700

Alan Kaspar
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 September 2006 appealing from the Office action mailed 22 November 2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed. Appellant states that there was an amendment filed on 22 May 2006. No such amendment is in the file.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,186,460	Fongeallaz et al.	02-1993
5,106,098	Filiczowski	04-1992
6,371,854	Ikeda et al.	04-2002
4,874,177	Girardin	10-1989

Wikipedia, Churchill Downs, http://en.wikipedia.org/wiki/Churchill_Downs, page 2

Churchill Downs Race Track, <http://www.horseracing.info/churchill-downs-race-track.html>

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6, 8-11, 13, 15-18, 20, 22, 24-26 & 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fongeallaz in view of Filiczkowski (US Patent Number 5,106,098) and Nakagawa, et al. (EP 0757917).

Claims 1, 8, 15: Fongeallaz teaches a computerized game system with a racing field formed on a predetermined board (Fig 13) that is electronically displayed on a screen. There is a running model to which an inherent ability parameter varying in accordance with a given environment is assigned. (Col 5, 41-45) The racing field (Fig 13) comprises a plurality of tracks (L1-L16) in which the running model runs based on a current ability parameter in accordance with the respective track. (Col 5, 40-56) These tracks clearly exist concurrently on the same game board. (Fig 13) Fongeallaz does not specifically teach independent tracks. Filiczkowski teaches independent tracks (abstract), i.e., a dirt track and a turf track (Fig 1B). The ability parameter is changed according to the

movement of the running model from one of the plurality of tracks to another of the plurality of tracks. The horse runs on a dirt track when running on the outside track and a turf track when running on the inner track. Filiczkowski teaches that this allows the invention to closely simulate actual horse race track action. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz track in view of Filiczkowski's teachings to include independent tracks (i.e., a dirt track and a turf track) in order to simulate actual horse track action.

Filiczkowski teaches that the physical running models that can run races on both tracks. (Abstract) The starting posts are essentially passageways formed between the plurality of concurrently existing tracks so that the running models can enter the tracks. The finish lines are essentially passageways formed between the plurality of concurrently existing tracks so that the running models can exit the tracks. They are not, however, physical passageways for use by physical running models. Nakagawa teaches physical passageways for use by physical running models. (Page 6, 33-36) Physical models are well known to attract players. Physical models demand physical passageways – they have to have some manner of moving around on the playing surface. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz and Filiczkowski and Nakagawa to have physical passageways for use by physical running models in order to facilitate movement of the physical running models (which attract players) on the game board.

Claims 2, 3, 9, 10, 16, 17: Fongeallaz teaches the invention substantially as claimed.

Fongeallaz teaches use of a track with regions having different attributes. (Col 5, 40-62)

For instance, Fongeallaz suggests use of dry track and mud track attributes. (Col 5, 43-45) Fongeallaz describes a steeplechase game in which there are flat regions where the running model performs steady running in which the current ability parameter is maximized and in other regions there is a region formed so as to obstruct the steady running (obstacles). (Col 5, 63-66) Fongeallaz fails to explicitly teach entire tracks where the current ability parameter of the running model is maximized or minimized. Filiczkowski teaches a dirt track and a turf track (Fig 1B) where the current ability parameter of the running model is maximized or minimized. Filiczkowski teaches that this allows the invention to closely simulate actual horse race track action. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz track in view of Filiczkowski's teachings to include a dirt track and a turf track where the current ability parameter of the running model is maximized or minimized in order to simulate actual horse track action.

Claims 6, 13, 20: Fongeallaz teaches the plurality of tracks form concentric racing courses. (Col 4, 36-43) Filiczkowski's Fig 1 B shows the plurality of tracks form concentric racing courses.

Claims 4, 11, 18, 22: Fongeallaz teaches the invention substantially as claimed.

Fongeallaz teaches use of a track with regions having different attributes. (Col 5, 40-62) For instance, Fongeallaz suggests use of dry track and mud track attributes. (Col 5, 43-45) While Fongeallaz does not specifically teach dirt and turf track sections, these are the two main types of tracks used in horseracing. Filiczkowski teaches a dirt track and a turf track. Filiczkowski teaches that this allows the invention to closely simulate actual horse

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race track action. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz track in view of Filiczkowski's teachings to include a dirt track and a turf track in order to simulate actual horse track action.

Claims 24-26: Filiczkowski clearly teaches that each track has a different surface. The horse runs on a dirt track when running on the outside track and a turf track when running on the inner track. (Col 2, 60-61)

Claim 29: Filiczkowski's tracks have variable (i.e., grass or dirt) and selectable (i.e., inner or outer) turf or soil conditions.

3. Claims 23 & 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fongeallaz, Filiczkowski and Nakagawa as applied to claim 1 or 22 above, and further in view of Ikeda et al. (US Patent Number 6,371,854).

Claims 23: Fongeallaz, Filiczkowski and Nakagawa teach the invention substantially as claimed. Fongeallaz teaches storing a "library" of data concerning the attributes and abilities of each running model. (Col 5, 50-62) Fongeallaz does not, however, specifically teach adding a game value to the "library" in accordance with the result of the race. Ikeda, a game in the same art, teaches allowing players to raise and train their own horses (running models). This training includes running races and recording the result of the race in the horse's library of information. Allowing players to raise and train their own horse gives the player a greater sense of involvement in the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Fongeallaz's library by add a game value to the horse's "library" of

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attributes in accordance with the result of the race as taught by Ikeda in order to allow the player to raise and train the horse, thus giving the player a greater sense of involvement in the game.

Claim 28: Ikeda teaches training of the running model. This would include training it on one or more of the plurality of tracks.

4. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fongeallaz in view of Filiczowski (US Patent Number 5,106,098) and Nakagawa, et al. (EP 0757917) as applied to claim 1 in view of Girardin (US Patent Number 4,874,177).

Claim 27: Fongeallaz, Filiczowski, and Nakagawa teaches the invention substantially as claimed, but fail to teach that the physical running model is a selected one physical running model taken from a plurality of physical running models that differing on the basis of inherent ability parameters, said plurality of physical running models being displayed as a list at least on the basis of ownership and said selected one physical running model being eligible for selection from said list according to the type of track. Girardin teaches this. (Abstract and Fig 8.) This allows the player to choose a horse the player believes will have the best chance to win. This increases the strategy element of the game and makes it more enjoyable. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz, Filiczowski, and Nakagawa in view of Girardin so that the physical running model is a selected one physical running model taken from a plurality of physical running models that differing on the basis of inherent ability parameters, said plurality of physical running models being displayed as a list at least on the basis of ownership and said selected one physical running model being eligible for selection from said list according to the type of track in order to allow

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the player to choose a horse the player believes will have the best chance to win, thus increasing the strategy element of the game and making it more enjoyable.

(10) Response to Argument

Examiner's Overview

Appellant's invention is a simulation of a horseracing track. As is usual in such tracks, the track is in an oval shape. As with many actual tracks (see the descriptions of Churchill Downs Race Track), there is a dirt track on the outside and a turf track on the inside – thus forming two concentric ovals. As with actual tracks, there is a fence between these two tracks and an opening or gate in this fence through which horses (i.e., running models) may pass. The primary issues on appeal concern whether it would be obvious when simulating a horseracing track to have the two concentric tracks and whether or not it would be obvious to have that gate.

There is a clear teaching in the prior art (Filiczowski) that having two concentric oval tracks with differing characteristics better simulates an actual racetrack. Furthermore, there is a teaching in the prior art (Nakagawa) that when physical model horses are used in conjunction with a computer simulation of a racetrack, there must be a gate to allow access to the starting post. But there is no explicit teaching that there is a passageway or gate between the two tracks.

Examiner contends that it is obvious to put in such a gate in the simulation in order to allow the model horses to have access to the inner track. Appellant disagrees. Appellant argues, rather voluminously, that the applied references fail to explicitly teach such a gate between the two tracks. This is true. Even the descriptions of Churchill Downs do not specifically mention such a gate. But on a real racetrack, the gate exists – common sense demands such a gate.

Horses must have access to the inner track. And in a simulation that uses physical models of

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horses, the models must have a passageway between tracks if they are to gain access to the various tracks.

Response to Arguments

ISSUE 1

Appellant argues that the prior art fails to teach a computerized game in which there are physically different, concurrently existing, tracks upon which the models horses run (i.e., a turf track inside a dirt track). Examiner disagrees.

Fongeallaz teaches a computerized horseracing game. In the game, the horses have different abilities depending on the type of track upon which the race is being run. (Col 5, 40-62) Fongeallaz does not, however, teach physically different, concurrently existing, tracks. Filiczowski clearly teaches “two independent and concentric tracks that simulate dirt and turf track conditions, respectively.” (Abstract) Filiczowski teaches that this arrangement closely simulates actual racetrack conditions – a fact that those who have visited a racetrack such as Churchill Downs know to be true. Surely, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz in view of Filiczowski to have “two independent and concentric tracks that simulate dirt and turf track conditions, respectively,” in order to more closely simulate actual racetracks.

Appellant argues that the prior art fails to teach a physical passageway between the outer and inner tracks. As pointed out above, actual racetracks have such a passageway or gate. Furthermore, Filiczowski can also reasonably be interpreted as teaching a passageway. The starting posts are essentially passageways formed between the plurality of concurrently existing tracks so that the running models can enter the tracks. The finish lines are essentially

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passageways formed between the plurality of concurrently existing tracks so that the running models can exit the tracks. The starting post & the finish line are not, however a gate.

Nakagawa teaches that passageways (i.e., gates) are necessary for allowing physical “running models” (i.e., model horses) to have access to a track. (Discussion of Fig 3 on page 6.) As a simple matter of logistics, there must be a gate between the two tracks. This conclusion is not based on hindsight – it is based on the requirements of physical devices.

Fongeallaz

Appellant argues that Fongeallaz’s “lanes” do not represent “tracks”. While a “lane” is, of course, a “track”, the issue is moot – as pointed out in the rejection, Filiczowski clearly teaches two “tracks”.

Appellant is correct in arguing that Fongeallaz does not teach physical model horses or gates – both Filiczowski and Nakagawa teach these features. Fongeallaz represents the horses on the track by crosshatching areas of the track. This, of course, is not a very close simulation of a horse race – horses do not look like crosshatching.

Appellant states that there is no teaching of any running model having different ability parameters and running on different tracks according to those different parameters. This is contrary to fact. Fongeallaz clearly teaches assigning ability parameters to different horses and having the horses run on different tracks according to those ability parameters. (Col 5, 40-62) For instance, Fongeallaz states that one horse may be assigned a dry track ability and another a mud track ability. The horses would run differently depending on track conditions. For instance, the horse with mud track ability would be assigned more energy than the dry track horse if the track were muddy. This concept would also apply to the difference between a dirt track and a

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turf track. Thus Appellant's statement that "Fongellaz et al. has little, if any, relevant teaching with respect to the claimed invention" (Brief, page 16), is clearly erroneous.

Filiczkowski

Appellant admits that Filiczkowski teaches concurrently existing concentric tracks. Appellant admits that Filiczkowski makes use of physical model horses. But Appellant argues that Filiczkowski fails to teach a computer game or tell how to computerize the game it teaches. In fact, Appellant provides a litany of things Filiczkowski fails to teach – all of which (except the explicit teaching of a physical gate between tracks) are taught by either Fongellaz or Nakagawa. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Filiczkowski teaches that having concurrently existing concentric tracks with different attributes (i.e., dirt & turf) and physical model horses creates a game that more closely simulates an actual racetrack. More closely simulating an actual racetrack is, of course, the goal of anyone creating a horse race simulation.

Nakagawa et al.

Appellant argues that Nakagawa fails to teach the limitations taught by Fongellaz & Filiczkowski, thus engaging in piecemeal analysis. Appellant admits that Nakagawa teaches a computer race game with physical horse models and a physical passageway to the starting gate.

Nakagawa teaches the implementation of the game taught by the other references. It shows how to take Filiczkowski's model horses and multiple tracks & use them with a computer

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game such as that taught by Fongeallaz. Furthermore, it teaches that with such a game, a physical passageway is necessary to allow for movement of the model horses to the various starting gates – just as a gate is necessary at a real horse track to allow for the movement of real horses.

Basis for Patentability

Appellant argues that none of the references teach a computerized game with a plurality of concurrently existing tracks that are necessarily separate with different characteristics of the running models in accordance with the characteristic of the respective tracks. This is true of each reference taken individually, but the combination of the references teaches the claimed invention. Appellant cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant argues that Fongeallaz is incompatible with plural concurrent tracks. This argument is apparently based on the idea that it is impossible to change Fongeallaz's display from simple straight lines to a curved track. This is simply not the case. Fongeallaz is implemented using a computer program. It teaches representing a racetrack as an array of straight lines. But computer graphics capabilities made great strides in the decade between Fongeallaz's filing date and Appellant's filing date. There is absolutely no reason that some of these tracks or lanes cannot be segregated from the others and grouped into ovals as taught by Filiczowski – especially in view of Nakagawa's teaching of a computer game with a curved track. Appellant's argument that Fongeallaz has no capability of modification to have concurrent

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tracks for running models in accordance with the characteristics of the respective tracks simply does not take changes in technology into account.

Appellant argues that Filiczkowski is a board game and not a computer game. Again, this is merely piecemeal analysis. The question is not whether Filiczkowski teaches the invention, but what it would suggest to one of ordinary skill in that art *in combination with the other references*.

Filiczkowski teaches that having plural independent tracks with different attributes (i.e., a dirt track and a turf track) better simulates real horse tracks. Appellant's argument that this is merely for the convenience of packaging in a board game is belied by the fact that actual racetracks such as Churchill Downs adopt the configuration shown by Filiczkowski. Thus there is every reason to believe Filiczkowski's assertion that the arrangement better simulates a real racetrack – the statement is demonstratively true.

Filiczkowski also suggests using physical models of horses. Model horses certainly are more realistic than Fongeallaz's crosshatching. One skilled in the art would strive for realism in a simulation. The more realistic the simulation, the more popular it will be.

Appellant argues that there is no motivation to combine the references. Examiner disagrees. Fongeallaz teaches a racing game very much like that of the Appellant's. But Fongeallaz's racetrack does not look like real racetracks and Fongeallaz's crosshatching does not look like a real horse. In fact Appellant argues on page 23 of the Brief that Fongeallaz's racetrack does not look like a racetrack at all. Appellant accurately states that Fongeallaz's "simulated array is nothing but a group of rows of display elements..." As one of ordinary skill in the art would have recognized, Fongeallaz's display looks nothing like a racetrack.

Filiczkowski teaches that having two concentric racetracks with differing attributes and physical horse models better simulates a real racetrack. Anyone who has visited a racetrack such as Churchill Downs would have to agree. Certainly, one of ordinary skill would be motivated to simulate a real racetrack as closely as possible.

But that begs the question, “How can this actually be accomplished?” As Appellant points out on page 24 of the Brief, it would be wrong to require undue experimentation. Certainly, the layout of the track would not require undue experimentation. But how can physical model horses be used with computer games? That is the real technical question.

Nakagawa answers that question. Nakagawa teaches the mechanics of using physical models of horses with a computerized race game. The teachings of Nakagawa mean that no undue experimentation is required. One of ordinary skill trying to improve Fongellaz by implementing Filiczkowski’s suggestion to use concentric tracks and physical models of horses can look to Nakagawa for a information on how to accomplish this task. And one of the things that Nakagawa teaches is that if one uses physical models, one must provide passageways to allow movement of the models to the various starting gates – thus rendering the “missing” limitation obvious.

In spite of Appellant’s assertion to the contrary, there is ample motivation for the combination of the references and these references do indeed teach the claimed invention.

Dependent Claims 4, 11, and 18

Appellant fails to argue the separate patentability of these claims, instead merely pointing out additional limitations (i.e., that the two tracks in question are a dirt track and a turf track).

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Thus these claims must stand and fall with claim 1. Further, Filiczowski clearly teaches a dirt track and a turf track. (Abstract)

Dependent Claims 2, 3, 9, 10, 16 & 17

Appellant fails to argue the separate patentability of these claims, instead merely pointing out additional limitations, thus these claims must stand and fall with claim 1. Further, Fongellaz teaches varying the ability of the horse based on track attributes. This would obviously include the varying the horse's ability based on the difference between dirt and turf tracks. Filiczowski clearly teaches separate dirt and turf tracks.

Dependent Claims 6, 13 & 20

Appellant fails to argue the separate patentability of these claims, instead merely pointing out additional limitations, thus these claims must stand and fall with claim 1. Furthermore, Fongellaz teaches simulating oval tracks by use of free spaces on the inner lanes. (See discussion of Fig 13.) Filiczowski depicts oval concentric tracks. As discussed in great detail above, it is obvious to use concentric oval tracks to better simulate an actual racetrack.

Independent Claim 22

Appellant fails to argue the separate patentability of this claim, instead summarizing the arguments made in connection with claim 1. Thus the claim must stand and fall with claim 1.

Dependent claim 29:

Appellant fails to argue the separate patentability of these claims, instead merely pointing out additional limitations, thus these claims must stand and fall with claim 1. Further, Appellant's argument that selection of turf or soil conditions includes "depth, hardness, roughness and the like" or "viscosity or the like", is not commensurate in scope with the claims.

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None of these factors are mentioned in the claims and it would be inappropriate to import them from the specification. In addition, Fongeallaz teaches selectable dry tracks and mud tracks – a difference in viscosity.

ISSUE 2

Dependent Claim 23

Appellant indicates that claim 23 stands and falls with claims 22.

Dependent Claim 28

Appellant states that the Ikeda reference does not cure the supposed deficiencies of claim 1. Thus this claims stands and falls with claim 1.

ISSUE 3

Appellant fails to argue the separate patentability of these claims, instead merely pointing out additional limitations, thus these claims must stand and fall with claim 1.

Appellant argues that Girardin fails to teach allowing the player to train his horse. This is absolutely true – and also absolutely moot because the limitation does not appear in the claim. Appellant does not argue that Girardin fails to teach the claims limitation – allowing the player to pick a horse off of a list based on inherent abilities. In fact, he appears to agree that it has this feature.

Appellant engages in yet another piecemeal argument by arguing that the game disclosed by Girardin uses dice instead of a computer. This ignores the teachings of the other references, at least two of which teach computerized race games.

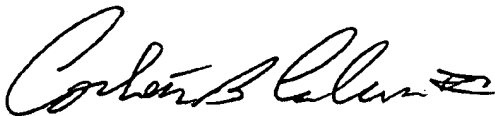
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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



**CORBETT B. COBURN
PRIMARY EXAMINER**

Corbett Coburn, Primary Examiner

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